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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,486	02/11/2002	John R. Martin	13267US02	6208

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EXAMINER	
BAYAT, BRADLEY B	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/073,486	MARTIN ET AL.	
	Examiner	Art Unit	
	Bradley B. Bayat	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant has amended claims 1 and 11 and added new claims 18-20 in the response filed on May 2, 2005. Thus, claims 1-20 remain pending.

Response to Arguments

Applicant's arguments filed May 2, 2005 have been fully considered but they are not persuasive.

As per claims 1 and 11, applicant contends that the cited reference (Nathan, 6,755,744) "does not explicitly describe, or inherently disclose, that the game machine provides additional jukebox functionality [or] that the game machines exercises control over the operation of the jukebox (applicant's response pages 7-8)." In fact, applicant concedes that Nathan discloses a system for selecting between two operating modes, however, asserts that one mode is merely for selection of payment functions. Id. Applicant's amendment to claims 1 and 11 are aimed to demonstrate applicant's argument that the control subsystem exercises control over both the game and jukebox subsystem.

The examiner respectfully disagrees with applicant's mischaracterization of the Nathan reference. Nathan clearly discloses a communication device and method for switching operating modes between an electronic game machine and a jukebox (column 3). Nathan describes switching from a game function to a jukebox function for selecting and playing music or to pay for credits in order to be able to play a game or a song in the event that none exists (column 4, lines 20-37). Applicant's specification describes Nathan's scenario of switching between a game and song selection mode (specification ¶39). Moreover, as clearly claimed in Nathan, a user can switch functionality from a game mode to a song selection mode or to a payment mode

(column 12, lines 29-52). Thus, applicant's arguments with respect to claims 1 and 11 are not persuasive.

As per dependent claims 4, 9, 12 and 15, applicant contends that Nathan fails to explicitly disclose a dart game machine and "even teaches away from certain types of dart game machines (response page 8)." Applicant contends that the electronic game machines in Nathan "**must** include a video monitor" and since certain types electronic dart games do not require video monitors, applicant's claimed subject matter is patentable over Nathan (response pages 8-9). Again, applicant mischaracterizes the teaching of Nathan and provides arguments not supported in the claims.

Nathan does not limit the invention to any specific type of electronic game and discloses a video monitor as one example of a viewing means (applicant's response page 8, "such as a video monitor..."). Thus applicant's argument limiting Nathan's invention to solely a video monitor is simply erroneous. More importantly, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the specific type of electronic dart games that do not require a video display) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, applicant should note that claims 4, 9,12 and 15 were rejected under obviousness and not solely under Nathan. Since Nathan discloses the use of the invention for any electronic game, it would have been obvious for one of ordinary skill in the art at the time of the invention to implement it with any electronic game, including an electronic dart game.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Nathan et al. (hereinafter Nathan), US 6,755,744 B1.

As per the following claim, Nathan discloses:

1. An entertainment system comprising: a game subsystem; a jukebox subsystem; and a control subsystem coupled to the game subsystem and the jukebox subsystem, the control subsystem and the game subsystem providing game functionality, and the jukebox subsystem and the control subsystem providing jukebox functionality, the control subsystem exercising control over the game subsystem and the jukebox subsystem (column 2, lines 45-60, column 10, lines 56-column 11, line 4; column 12, lines 30-52).

2. The entertainment system of claim 1, wherein the control system is responsive to at least one mode determining switch for specifying a mode of operation for said entertainment system (column 3, lines 23-40).

3. The entertainment system of claim 1, wherein the control subsystem comprises a central processor for controlling operation of the game subsystem and the jukebox subsystem apparatus (column 10, lines 42-43).

5. The entertainment system of claim 3, further comprising a data storage device coupled to said central processor, said data storage device storing digitized songs for the jukebox subsystem (column 2, lines 23-38).

6. The entertainment system of claim 3, wherein the central processor is operative to play audio data streamed from a remote server while providing jukebox functionality (column 8, lines 5-27; column 10, lines 42-43).

7. The entertainment system of claim 3, further comprising a communication interface for communicating with devices external to the entertainment system (column 10, lines 19-37).

8. The entertainment system of claim 1, wherein the jukebox subsystem comprises an audio data decoder, an amplifier, and at least one speaker (column 2, lines 23-31).

10. The entertainment system of claim 1, wherein the jukebox subsystem includes a jukebox interface physically separated from the entertainment system for allowing players to interact with the jukebox subsystem while other players interact with the game subsystem (column 7, lines 55-

65).

11. A method for providing an entertainment system having combined jukebox and game functionality, the method comprising: exercising control over both the jukebox and game functionality; operating in a current mode of operation corresponding to one of a jukebox mode, and a game mode; receiving a mode command; and determining a next mode of operation based on the mode command, the next mode of operation corresponding to one of a game mode and a jukebox mode (column 2, lines 45-60; column 3, lines 23-48, columns 10-11).

13. The method of claim 12, wherein said step of receiving a mode command comprises: providing an input device by which a patron may input the mode command; and detecting the mode command input by the patron (column 3, lines 23-40).

14. The method of claim 12, further comprising the step of playing jukebox music in the background during a game (column 7, lines 55-65).

16. The method of claim 12, wherein the determining step comprises determining the next mode of operation based on the mode command and on the current mode (column 7, lines 18-50).

17. The method of claim 12, further comprising resuming operation in a previous mode of operation when the current mode of operation is completed (column 8, line 48-column 9, line 67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 9, 12, 15 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nathan, 6,755,744 B1.

As per claims 4, 9, 12 and 15, Nathan discloses a method and system for providing an entertainment system having combined jukebox and game functionality, the method comprising: operating in a current mode of operation corresponding to one of a jukebox mode, and a game mode; receiving a mode command; and determining a next mode of operation based on the mode command, the next mode of operation corresponding to one of a game mode and a jukebox mode (column 2, lines 45-60; column 3, lines 23-48). Although Nathan discloses electronic game machines typically found in bars (column 2, lines 45-50), Nathan does not explicitly disclose a dart game.

Dart games are an old and well known in the electronic game art and typically found in entertainment establishments. It would have been obvious for one of ordinary skill in the art at the time of applicant's invention to implement Nathan's communication device and method between an electronic dart game and jukebox typically found in the same establishments in order to combine payment systems and reduce overall operating costs without limiting functionality for use of both systems to the user.

As per claims 18-20, As per claims 4, 9, 12 and 15, Nathan discloses a method and system for providing an entertainment system having combined jukebox and game functionality, the method comprising: operating in a current mode of operation corresponding to one of a jukebox mode, and a game mode; receiving a mode command; and determining a next mode of operation based on the mode command, the next mode of operation corresponding to one of a game mode and a jukebox mode (column 2, lines 45-60; column 3, lines 23-48, see rejection above). Although Nathan discloses electronic game machines typically found in bars (column 2, lines 45-50), Nathan does not explicitly a single unit housing the integral parts the entertainment system.

It has been well settled that by providing a single unit or a housing for making integral structures disclosed in the prior art would be merely a matter of obvious engineering choice. *In re Larson*, 144 USPQ 347, 349; 339 US 965 (CCPA 1965); *In re Wolfe*, 116 USPQ 443, 444; 251 F2d 854 (CCPA 1958). It would have been obvious for one of ordinary skill in the art at the time of the invention to include Nathan's game, jukebox and control units in one housing as an obvious engineering choice in order to minimize use space for the entertainment system which is typically found in entertainment establishments and bars.

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as

potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US PATENT 5,341,350 to Frank et al.
- US PATENT 6,804,825 B1 to White et al.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8am-6: 30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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